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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,314	08/31/2001	Martin W. Masters	2001P16282US	2179

7590 05/18/2004

Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
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EXAMINER

LAZOR, MICHELLE A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,314

Applicant(s)

MASTERS ET AL.

Examiner

Michelle A Lazor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art.

The admitted prior art discloses imparting a smooth texture to the outer surface of a shell of a hearing instrument (page 2, lines 4 – 10). Thus the admitted prior art discloses all the limitations of Claims 1, 2, 8 and 9, and anticipates the claimed invention.

3. Claims 1 – 3 and 8 – 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter (U.S. Patent No. 3567871).

Walter discloses imparting a non-smooth texture to the outer surface of a shell of a hearing instrument (Figure 1; column 2, lines 49 – 54). Thus the Walter discloses all the limitations of Claims 1 – 3 and 8 – 10, and anticipates the claimed invention.

4. Claims 1 – 3 and 8 – 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowser et al. (U.S. Patent No. 5581627).

Bowser et al. disclose imparting a non-smooth texture to the outer surface of a shell of a hearing instrument (Figures 1B, 5A, and 5B; column 3, lines 34 – 54). Thus the Bowser et al. disclose all the limitations of Claims 1 – 3 and 8 – 10, and anticipate the claimed invention.

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5. Claims 1 – 3, 6, 8 – 10, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoerkens (U.S. Patent No. 4803853).

Hoerkens discloses a method of fabricating a hearing instrument, comprising fabricating a shell comprising an outer surface comprising a series of layers (column 2, lines 35 – 41); and imparting a non-smooth texture to at least a portion of the outer surface of the shell by way of using a mesh screen, which comprises waveforms to the edges of one or more of the layers during the process of fabrication (Figures 1 – 6; column 1, lines 45 – 56). Thus Hoerkens discloses all the limitations of Claims 1 – 3, 6, 8 – 10, 13, and 16, and anticipates the claimed invention.

6. Claims 1, 2, 4, 8, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoest et al. (U.S. Patent No. 6097825).

Yoest et al. disclose a method of fabricating a hearing instrument, comprising fabricating a shell comprising an outer surface (Figure 4); and imparting a texture to at least a portion of the outer surface of the shell, which comprises imparting a non-reflective finish (column 1, line 65 – column 2, line 2). Thus Yoest et al. disclose all the limitations of Claims 1, 2, 4, 8, 9, and 11, and anticipate the claimed invention.

7. Claims 1 – 3, 5, 7 – 10, 12, and 14 – 17 are rejected under 35 U.S.C. 102(a) as being anticipated by Widmer et al. (U.S. Patent No. 6595317).

Widmer et al. disclose a method of fabricating a hearing instrument, comprising fabricating a shell comprising an outer surface that is fabricated from a mold cavity derived from surface contours of the user's ear and which comprises a series of layers; applying a laser to the surface (column 5, lines 4 – 29; column 6, lines 39 – 57); and imparting a non-smooth texture to

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at least a portion of the outer surface of the shell that includes a series of lines or ribs (Figures 18 – 20; column 13, lines 36 – 54). Thus Widmer et al. disclose all the limitations of Claims 1 – 3, 5, 7 – 10, 12, 14, 15, and 17, and anticipate the claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widmer et al. as applied above in Claims 2 and 9, in view of Hoerkens.

Widmer et al. disclose all the limitations of Claims 2 and 9, but do not specifically disclose imparting a texture that comprises applying waveforms to the edges of one or more of the layers during the process of fabrication. However, Hoerkens discloses applying waveforms to the edges of one or more of the layers during the process of fabrication (Figures 1 – 6; column 1, lines 45 – 56). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to apply waveforms to the edges of one or more of the layers during the process of fabrication to permit the hearing aid to be worn inconspicuously (column 2, lines 42 – 51).

Response to Arguments

10. Regarding the arguments presented by the Applicant with respect to claims 1 – 3, 6, 8 – 10, 13, and 16, Examiner disagrees. Hoerkens clearly discloses imparting a texture to a hearing instrument shell by way of using a mesh screen (Figures 1 – 6; column 1, lines 45 – 56). The

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Merriam-Webster dictionary definition of texture is an "identifying quality; character", which would be consistent with the definition of texture to one of ordinary skill in the art. Since there was no specific and different definition of the word "texture" in the specification, the broadest, most reasonable interpretation was given. The excerpt referred to in the Applicant's specification refers to a portion of a handbook that outlines how to control surface texture, but does not give a different definition of the word "texture" as is commonly understood.

11. Regarding the arguments presented by the Applicant with respect to claims 1, 2, 4, 8, 9, and 11, Examiner disagrees. Yoest et al. disclose imparting a non-reflective finish (column 1, line 65 – column 2, line 2), thereby imparting a texture (considered to be "an identifying quality or character").

12. Regarding the arguments presented by the Applicant with respect to claims 1 – 3, 5, 7 – 10, 12, and 14 – 17, Examiner disagrees. "Imparting a texture to at least a portion of the outer surface of the shell" is construed to include modifying the outer surface of the shell by using an outer rib pattern, as discussed in Widmer et al. (column 13, lines 36 – 41). In addition, claims 37, 42, and 46 of Widmer et al. each disclose the outer surface to include a rib pattern.

13. Regarding the arguments presented by the Applicant with respect to claims 6 and 13, Examiner disagrees. Pleats that are preferably curved, as discussed by Hoerkins (column 1, lines 45 – 56) are considered to be waveforms. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., selective laser sintering and stereo lithography) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

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USPQ2d 1057 (Fed. Cir. 1993). In addition, the reason why it is considered obvious to incorporate the invention of Hoerkins into the invention of Widmer et al. is so that the hearing device can be made inconspicuous, as was discussed in the office action (2/3/04). Finally, imparting a texture on the outer surface of the hearing instrument is anticipated by Widmer et al., and discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 571-272-1232. The examiner can normally be reached on Mon - Wed 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAL
5/11/04


MICHAEL COLAIANNI
PRIMARY EXAMINER